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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/980,434      | 11/28/2001  | Hiroyuki Yamamoto    | 9683/95             | 3419             |

7590 12/15/2005  
Brinks Hofer Gilson & Lione  
P O Box 10395  
Chicago, IL 60610

EXAMINER

RAMPURIA, SHARAD K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2688

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/980,434 | <b>Applicant(s)</b><br>YAMAMOTO ET AL. |  |
|                              | <b>Examiner</b><br>Sharad Rampuria   | <b>Art Unit</b><br>2688                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

I. The current office-action is in response to the application filed on 9/7/05.

Accordingly, Claims 1-62 are pending for further examination as follows:

#### *Double Patenting*

II. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

III. Claims 1-62 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of copending Application No. 09/786818 (based on claims amended on 09/23/2005).

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, but they are not patentably distinct from each other because all of the claimed limitations of the present U.S. Application No. 09/980434 for example, Claim 1 is explained in following table, is transparently found in Claim 11 of copending U.S. Application No. 09/786818 with obvious wording variations.

| <p><i><b>Instant Claim of U.S. Application No.</b></i></p> <p><i><b>09/980434</b></i></p>   | <p><i><b>Related Claim of copending U.S. Application</b></i></p> <p><i><b>No. 09/786818</b></i></p>  |
|---|--|
| <p>1. A location reporting method, comprising the steps of:</p>   | <p>11. A location information notifying method for notifying a predetermined computer, location information of a mobile communication terminal obtained from a mobile communication network which contains mobile communication terminal capable of wireless communication said location information notifying method comprising: relaying communication between a mobile communication terminal and a computer, wherein said communication includes identification information of said mobile communication terminal;</p> |
| <p>Receiving by a mobile communication terminal, from a computer through a mobile communication network, down data containing a request for location information;</p> | <p>Receiving from said computer a request signal requesting location information of said mobile communication terminal;</p>  |
| <p>Acquiring by said mobile communication terminal location information indicating the location of itself; and</p>  | <p>Detecting the location of said mobile communication terminal in response to said request signal based on said identification</p>  |

|  |   |
|--|---|
|  | information, and generating location information of said mobile communication terminal;   |
| Transmitting, by said mobile communication terminal, after adding said acquired location information to said received data, said data to said computer as up data. | Detecting a predetermined data sequence within data transmitted from said mobile communication terminal to said computer; and substituting said predetermined data sequence with said identification information. |

***Claim Rejections - 35 USC § 102***

IV. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

V. Claims 1-11, 14-36, & 39-62 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kimoto et al. [US 6115611]

Regarding Claims 1, 14-19, 23, 27, 40, 43-44, 46, 49, 52-54 Kimoto disclosed a location reporting method (Abstract), comprising the steps of:

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Receiving by a mobile communication terminal (1F; Fig.1), from a computer (2B; Fig.1) through a mobile communication network, down data containing a request (i.e. In the information center 2E, the retrieving unit 22E retrieves corresponding information or service in the accumulating unit 21E on the basis of the request from the mobile terminal 1J, and the information/service transmitting unit 23E, takes out the retrieved information or service from the accumulating unit 21E, and sends the information or service to the mobile terminal 1J. The mobile terminal 1J accumulates the received information or service in the accumulating unit; col.27; 17-25) for location information; (col.16; 23-33 and Claim 1)

Acquiring by said mobile communication terminal location information indicating the location of itself; (i.e. The up-load data transmitting unit 13 transmits information or a service relating to the above position information as up-load data to the information center 2. The information/service utilizing unit 14 utilizes information or a service relating to the position information transmitted from the information center 2; col.16; 23-33) and

Transmitting, by said mobile communication terminal, after adding said acquired location information to said received data, said data to said computer as up data. (i.e. In the information center 2, the accumulating unit 21 accumulates information or a service relating to information of a position according to a movement of the mobile terminal 1. The retrieving unit 22 receives position information transmitted from the mobile terminal 1, and retrieves information or a service relating to the position information accumulated in the accumulating unit 21. The accumulation controlling unit 23 accumulates in the accumulating unit 21 the information or the service relating to position information as up-load data transmitted through the up-load data transmitting unit 13 in the mobile terminal 1. The information/service transmitting unit 24 takes

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out information or a service relating to the position information retrieved by the retrieving unit 22 from the accumulating unit 21, and transmits the information or the service relating to the position information to the mobile terminal 1 having transmitted the position information; col.16; 34-50)

Regarding Claims 2-7, 28-32, 50-51, 55-57, 61-62 Kimoto disclosed A location reporting method as described in claims 1, 27, 49 respectively, wherein said steps performed by said mobile communication terminal further include the step of: detecting whether said down data contains a character string requesting location information acquisition time; wherein, said acquiring step further includes acquiring the acquisition time of said location information; and wherein, said transmitting step further includes adding said acquired location information acquisition time before transmission. (Col.34; 52-64)

Regarding Claims 8-10, 33-35, 58-60 Kimoto disclosed A location reporting method as described in claims 1, 27, 49 respectively, wherein, after said down data is received, said location information are acquired and transmitted at predetermined intervals. (Col.40; 25-40).

Regarding Claims 11, 24, 36, 38, 47 Kimoto disclosed A location reporting method as described in claims 1, 23, 27, 37, 46 respectively, wherein, said acquiring step includes generating, by said mobile communication terminal, the location of itself using a global positioning system. (Col.37; 47-57)

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Regarding Claims 20, 37 Kimoto disclosed A location reporting method as described in claims 1, 27 respectively, wherein, said computer is an information providing server for providing said mobile communication terminal with location-related information relating to the location of said mobile communication terminal. (Col.37; 63-col.38; 12)

Regarding Claims 21, 25 Kimoto disclosed A location reporting method as described in claims 1, 23, respectively, wherein, said computer is a terminal connected to a network and capable of transmitting and receiving data by radio or wire. (Col.37; 63-col.38; 12)

Regarding Claims 22, 26 Kimoto disclosed A location reporting method as described in claims 1, 23, respectively, wherein, said mobile communication terminal is a portable telephone for performing phone conversations by radio. (Col.37; 63-col.38; 12)

Regarding Claim 39, Kimoto disclosed A mobile communication terminal as described in claim 27, wherein, said acquiring means is capable of acquiring location information by a plurality of different location measuring methods, and said down data contains information designating a location measuring method; wherein, said acquiring means includes means for selecting a location measuring method designated by said down data, from among said plurality of the location measuring methods; and wherein, said transmitting means transmits, carried on said up data, location information acquired by said acquiring means according to said selected location measuring method. (Col.37; 47-57)



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Regarding Claim 41, Kimoto disclosed A mobile communication terminal as described in claim 39, wherein, said location measuring method includes either one of a method using a global positioning system, or a method of identifying a base station covering an area in which said mobile communication terminal is located. (Col.37; 47-57)

Regarding Claim 42, Kimoto disclosed A mobile communication terminal as described in claim 39, wherein said location information contains: latitude and longitude; or information based on an administrative classification. (Col.37; 47-57)

Regarding Claim 45, Kimoto disclosed A mobile communication terminal as described in claim 27, wherein said mobile communication terminal is a portable telephone for performing phone conversations by radio. (Col.37; 63-col.38; 12)

VI. Claims 12-13, & 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimoto further in view of Fan et al. (US 5959577).

Regarding Claim 12, The above combination disclosed all the particulars of the claim except transmitting, by said mobile communication terminal, a request signal requesting a predetermined node of said mobile communication network to generate the location information. However, Fan teaches in an analogous art, that A location reporting method as described in claim 1, wherein, said acquiring step includes the steps of: transmitting, by said mobile communication terminal, a request signal requesting a predetermined node of said mobile communication

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network to generate the location information; generating, by said predetermined node, the location information of said mobile communication terminal in response to said request signal and transmitting said location information to said terminal; and receiving, by said mobile communication terminal, the location information transmitted from said node. (col.7; 47-67)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting, by said mobile communication terminal, a request signal requesting a predetermined node of said mobile communication network to generate the location information in order to provide a data network, such as the Internet, is involved in locating mobile units.

Regarding Claim 13, The above combination disclosed all the particulars of the claim except a plurality of satellites. However, Fan teaches in an analogous art, that A location reporting method as described in claim 12, further comprising the step of: receiving, by said mobile communication terminal, radio waves transmitted from a plurality of satellites constituting a global positioning system; wherein, said step of transmitting request signal includes transmitting information contained in a plurality of said received radio waves, together with said request signal; and wherein, said step of generating location information includes generating said location information using the information contained in said plurality of radio waves. (8; fig.1; col.5; 2-7) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a plurality of satellites in order to provide a GPS receiver, position information of a mobile unit is determined from positioning signals received from GPS satellites and pseudo-ranges derived from the positioning signals.

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Regarding Claim 37, The above combination disclosed all the particulars of the claim except transmitting, by said mobile communication terminal, a request signal requesting a predetermined node of said mobile communication network to generate the location information. However, Fan teaches in an analogous art, that A mobile communication terminal as described in claim 27, wherein, said acquiring means includes: request transmitting means for transmitting a request signal requesting a predetermined node of said mobile communication network to generate the location information; and location information receiving means for receiving the location information transmitted, in response to said request signal, from said node. (col.7; 47-67) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include transmitting, by said mobile communication terminal, a request signal requesting a predetermined node of said mobile communication network to generate the location information in order to provide a data network, such as the Internet, is involved in locating mobile units.

Regarding Claim 38, The above combination disclosed all the particulars of the claim except a plurality of satellites. However, Fan teaches in an analogous art, that A mobile communication terminal as described in claim 37, further comprising: means for receiving radio waves transmitted from a plurality of satellites constituting a global positioning system, wherein, said request signal transmitting means transmits information contained in said plurality of received radio waves, together with said request signal. (8; fig.1; col.5; 2-7) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a plurality of satellites in order to provide a GPS receiver, position information of a mobile unit is

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determined from positioning signals received from GPS satellites and pseudo-ranges derived from the positioning signals.

***Response to Argument***

VII. Applicant's arguments with respect to claims 1-62 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870. The examiner can normally be reached on M-F. (9-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or [EBC@uspto.gov](mailto:EBC@uspto.gov).

Sharad Rampuria  
Examiner  
Art Unit 2688

  
**GEORGE ENG**  
**PRIMARY EXAMINER**